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United States Patent and Trademark Office (USPTO)

37 CFR Parts 1, 3, 5, and 10

[Docket No.: 980826226-0202-03]
RIN 0651-AA98

Changes To Implement the Patent Business Goals

Part II

65 FR 54604

DATE: Friday, September 8, 2000

ACTION: Final rule.

To view the next page, type .np* TRANSMIT.
To view a specific page, transmit p* and the page number, e.g. p*1

[*54604]

SUMMARY: The United States Patent and Trademark Office (Office) has established business goals for the organizations reporting to the Commissioner for Patents (Patent Business Goals). The focus of the Patent Business Goals is to increase the level of service to the public by raising the efficiency and effectiveness of the Office's business processes. In furtherance of the Patent Business Goals, the Office is changing the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify the provisions of the rules of practice.

DATES: Effective Dates: This rule is effective November 7, 2000, except that the changes to §§ 1.27, 1.78, 1.131, 1.132, 1.137, 1.152, 1.155, 1.324, 1.366, 1.740, and 1.760, and the removal of § 1.44 are effective September 8, 2000.

Applicability Dates: Computer program listings in compliance with former § 1.96 will be accepted until March 1, 2001. After that date, computer program listings must comply with revised § 1.96. Amendments in compliance with former § 1.121 will be accepted until March 1, 2001. After that date, amendments must comply with revised § 1.121.

The new two-year limit for requesting refunds under § 1.26 will be applied to any fee paid regardless of when it was paid. For previously paid fees, the two-year time period for requesting a refund will expire on the later of November 7, 2000 or the date that is two years from the date the fee was paid.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein ((703) 305-8713) or Robert W. Bahr ((703) 308-6906), Senior Legal Advisors, or Robert J. Spar, Director ((703) 308-5107), Office of Patent Legal Administration (OPLA), directly by phone, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Box Comments-Patents, Commissioner for Patents, Washington, D.C. 20231.

possible. Providing a marked up version, in today's environment of easy-to-use software to accomplish this result, is not anticipated to be that burdensome to applicants.

Comment 63: One comment suggested that the requirement for replacement paragraphs/claims not be made applicable to examiner amendment practice in order to encourage amendments that expedite prosecution.

Response: This suggestion has been adopted with the inclusion of an exception for examiners when preparing examiner's amendments. Examiners will not be required to rewrite paragraphs of the specification or claims in an examiner's amendment when preparing an application for allowance, nor will a marked up version be required.

Comment 64: One comment questioned whether applicants could present in a single paper, a clean version of all of the pending claims in the application.

Response: In view of the fact that many pending applications will include amendments made prior to the effective date of the rule change as well as amendments made subsequent to the effective date of the rule change, the suggestion that all of the claims be re-presented in a single paper in clean form is reasonable and will be permitted in the final rule as an option. See § 1.121(c)(3). No accompanying marked up version will be necessary, unless the paper being submitted also includes amendments to some of the claims. In that case, a marked up version of only the claims being amended in the current paper will be required. It will be understood by the Office that any claims not accompanied by a marked up version will constitute an assertion that they have not been changed relative to the immediate prior version.

Section 1.125: Section 1.125(b)(2) is amended to require that all the changes to the specification (rather than simply all additions and deletions) be shown in a marked up version, with the term "version" being substituted for the term "copy" to avoid any confusion as to what is supposed to be supplied. Section 1.125(b)(2) is also amended to provide that numbering the paragraphs of the specification of record is not considered a change that must be shown. Thus, the marked up version of the substitute specification need not show the numbering of the paragraphs of the specification of record, and no marked up version of the substitute specification is required if the only change is numbering of the paragraphs of the specification of record. Section 1.125(c) is amended to encourage that the paragraphs of any substitute specification be numbered in a manner consistent with § 1.52(b)(6).

Section 1.131: The heading of § 1.131 is amended to clarify that it applies to overcoming other activities in addition to cited patents or publication (by deletion of the recitation to only a cited patent or publication). Section 1.131(a) is also amended for simplicity.

Section 1.131(a) is specifically amended to provide that when any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or a party qualified under §§ 1.42, 1.43, or § 1.47 may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. Section 1.131(a) is amended to eliminate the provisions that specify which bases for rejection must be applicable for § 1.131 to apply. Instead, the approach is that § 1.131 is applicable to overcome a rejection unless the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n) (§ 1.131(a)(1)) or a statutory bar. This avoids the situation in which the basis for rejection is not a statutory bar (under 35 U.S.C. 102(a) based upon prior use by others in the United States) and should be capable of being antedated, but the rejection is not specified as a basis for rejection that must be applicable for § 1.131 to apply.

Affidavits under § 1.131 to overcome rejections based on prior knowledge or use under 35 U.S.C. 102(a) are effective on the date of publication in the Federal

Register for all pending applications where such issue needs to be addressed (to include appropriately filed requests for reconsideration).

Section 1.131(a) is also amended to provide that the effective date of a U.S. patent is the date that such U.S. patent is effective as a reference under 35 U.S.C. 102(e). MPEP 2136.03 provides a general discussion of the date a U.S. patent is effective as a reference under 35 U.S.C. 102(e). Finally, § 1.131(a) is amended to provide that prior invention may not be established under § 1.131 if either: (1) The rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n); or (2) the rejection is based upon a statutory bar.

Section 1.132: Section 1.132 is amended to eliminate the provisions that specify which bases for rejection must be applicable for § 1.132 to apply. Instead, the approach is that § 1.132 is applicable to overcome a rejection unless the rejection is based upon a U.S. patent to another or others that claims the same patentable invention as defined in § 1.601(n). Section 1.132 is specifically amended to state that: (1) When any claim of an application or a patent under reexamination is rejected or objected to, an oath or declaration may be submitted to traverse the rejection or objection; and (2) an oath or declaration may not be submitted under this section to traverse a rejection if the rejection is based upon a U.S. patent to another or others that claims the same patentable invention as defined in § 1.601(n).

Affidavits under § 1.132 to overcome rejections based on prior knowledge or use under 35 U.S.C. 102(a) are effective on the date of publication in the Federal Register for all pending applications where such issue needs to be addressed (to include appropriately filed requests for reconsideration).

Sections 1.131 and 1.132 are procedural in nature providing mechanisms for the submission of evidence to antedate or otherwise traverse a rejection; however, they do not address the substantive effect of the submission of such evidence on the objection or rejection at issue. See, e.g., *In re Zletz*, 893 F.2d 319, 322-23, 13 USPQ2d 1320, 1322-23 (Fed. Cir. 1989) (§ 1.131 provides an ex parte mechanism whereby a patent applicant may antedate subject matter in a reference); *Newell Cos. v. Kenney Mfg.*, 864 F.2d 757, 768-69, 9 USPQ2d 1417, 1426-27 (Fed. Cir. 1988) (the mere submission of evidence under § 1.132 does not mandate a conclusion of patentability). An applicant's compliance with §§ 1.131 or 1.132 means that the applicant is entitled to have the evidence considered in determining the patentability of the claim(s) at issue. It does not mean that the applicant is entitled as a matter of right to have the rejection of or objection to the claim(s) withdrawn.

Section 1.133: Section 1.133 (a) is amended to create §§ 1.133(a)(1) through (a)(3). Section 1.133(a)(1) provides that interviews must be conducted on "Office premises" (rather than "in the examiner's rooms"). The purpose of this change is to account for interviews conducted in conference rooms or by video conference.

Section 1.133(a)(2) is amended to conform to the practice in MPEP 713.02 (of ordinarily) providing for an interview relating to patentability of a pending application where the [*54641] application is a continuing or substitute application. The paragraph is also amended by changing interview to the singular to clarify that ordinarily a single interview prior to first Office action is permitted in a continuing or substitute application.

Comment 65: One comment urged that interviews be allowed in a CPA prior to a first Office action.

Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP.

Section 1.136: Section 1.136(c) is added to provide that if an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of